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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/605,628	02/22/1996	CHARLES B. SIMONE	S4264.000/P0	8170

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EXAMINER
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PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/605,628

Applicant(s)

SIMONE, CHARLES B.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the amendment filed 10/19/04. Claims 1-9 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

3. The rejection of claims 1-6 is hereby withdrawn due to the amendment filed 10/19/04.
4. Claims 7-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In the present case, the recited steps in claim 7, do not apply, involve, use, or advance the technological arts since all of the individual components may broadly read on non-technological elements such as a pencil and paper the steps recited in claim 7 can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to conceptually evaluate a person's "insurability".

As to technological arts recited in the preamble (i.e., "a computer system"), mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, the current claim language recites that gathered information is received and stored in the memory of a computer system. Such a recitation is still considered to be a trivial recitation of technology and is not sufficient to overcome the rejection claim 7 under 35 U.S.C. 101. In other words, the technology must be involved in one of the core steps of the invention (e.g. the assigning of weights, assigning of risks, creating an insurance comparison, or determining level of insurance risk) to be considered a practical application in the technological arts.

Dependent 8 also does not provide any further limitations that would serve to apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts."

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the invention is

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directed to a "method for evaluating insurability of at least one individual", and thus produces a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 7-8 are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeTore et al. (4,975,840).

(A) As per claim 1, DeTore et al. disclose a computer system for evaluating a potentially insurable risk. The system comprises an application database which includes:

- a survey for gathering information into a computer system database pertaining to an individual's health and medical test; an entry means for inputting the gathered information (fig. 1, element 16; col. 4, lines 21-35);
- computer system database for receiving and storing the gathered information (fig. 1, element 12; col. 4, lines 21-35); and

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- means for assigning weight and risk value to stored information in a weighting file in the computer system database (col. 5, lines 19-col. 6, lines 35; col. 41, lines 48-64; Figure 1)

DeTore et al. further disclose:

- means for determining the total of weight and risk values and comparing the total values to the pre-defined values on the same claims (col. 42, lines 55-63) and a message or suggestion is provided for improving health and decreasing risk (col. 2, lines 31-38: cols. 19-22, "Treatment" section -- shows that messages are provided to an individual having a medical problem, hypertension, as well as suggestions on how to improve their health conditions; and cols. 35-36).

The system also determines the level of insurance risk and communicates the level of risk (col. 18, lines 11-32). DeTore et al. fail to recite that the information gathered from an individual also includes the lifestyle of that individual. However, many medical results are typically based upon the lifestyle of an individual. For example, certain behavioral patterns in lifestyle have a direct affect on an individual's medical status.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include lifestyle information as an independent category along with medical and health data gathered by the DeTore et al. system. The motivation to do so would be to quantitatively assign weight and risk value to lifestyle data for the reason of accurately influencing insurance rates.

(B) Claim 2 recites the risk values are assigned negative values for actions that increase risks and positive values for actions that decrease insurance risks. However, it is well known to one of ordinary skill in the insurance risk evaluation art that positive and negative values to insurance risks is indicative of the strengths and liabilities of an individual's insurability (see Fig. 12 and col. 18, lines 33-63 of DeTore).

(C) As per claim 3, DeTore et al. disclose a memory to store underwriter information (fig. 1, elements 24 and 26).

(D) As per claim 4, DeTore et al. disclose a questionnaire memory to store questionnaires and that an individual can select appropriate responses to lifestyle questions (col. 12, line 37 through col. 13, line 16).

(E) Claims 5-6 recite specific behavioral or lifestyle conditions of an individual such as the food intake of an individual, tobacco use, alcohol use, and an individual's pregnancy status. These are necessary information, which are taken into consideration by an insurance agent. Note col. 5, lines 31-32 & 40-57 and col. 10, lines 42-55 and paragraph bridging col. 19-20 to col. 21-22 of DeTore, which states: "... Factors associated with the development of essential hypertension include: positive family history of hypertensive disease, high salt intake, obesity, certain types of psychological stress, smoking, and a heavy intake of alcohol" (emphasis added). As per the recitation

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of pregnancy status, it would have been obvious to one of ordinary skill in the art to include pregnancy status within an individual's lifestyle information when buying insurance with the motivation of more accurately determining the insurable risk for that condition since DeTore clearly teaches the gathering of medical data such as prior medical problems, existing conditions, medications, and "any other information received from the applicant which may have a bearing on insurability" (DeTore; col. 4, lines 24-30) (emphasis added).

(F) Method claim 7 repeats the underlying process steps of the elements recited within system claim 1. Since the apparatus disclosed by DeTore also performs the underlying processes and activities recited (e.g., gathering information; receiving and storing; assigning weights values; assigning risk values; determining a total value; creating an insurance comparison; choosing pre-defined suggestions; providing messages; determining a level of risk; and communicating the risk level), claim 7 is therefore rejected under the same rationale given for claim 1.

(G) As per claim 8, DeTore et al. disclose that the gathering of information includes providing an individual with a questionnaire (col. 12, lines 62-66). It is readily apparent that, if a set of questions are provided to the individual, responses or answers should be received.



***Response to Arguments***

5. Applicant's arguments filed 10/19/04 regarding the rejection under 35 U.S.C. 101 have been fully considered.

The rejections of claims 1-6 under 35 U.S.C. 101 have been withdrawn due to the amendment filed on 10/19/04.

However, the rejections of claims 7-8 have been maintained. While the Examiner acknowledges that claim 7 has been amended, the amendments are not sufficient to overcome the 101 rejection. As explained in the current rejection, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. The current claim language recites that gathered information is received and stored in the memory of a computer system. Such a recitation is still considered to be a trivial recitation of technology.

In other words, the technology must be involved in one of the core steps of the invention (e.g. the assigning of weights, assigning of risks, creating an insurance comparison, or determining level of insurance risk) to be considered a practical application in the technological arts.

6. Applicant's arguments regarding the art rejection filed 10/19/04 have been fully considered but they are not persuasive.

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(A) Applicant argues that the instant (Applicant's) invention presents a plurality of survey questions (examples provided from the specification) and further includes a step of assuring the veracity of the respondent's answers by providing a separate set of questions to the respondent's doctor or lab technologist. The Applicant suggests that these features are lacking in the prior art of record.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (e.g. assuring the veracity of the respondent's answers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If there are specific types of data, which are required for the survey and which are required for use in specific processing/analysis steps, then these data should be recited within the claim. Otherwise, the Examiner must give the terms "information pertaining to lifestyle" or information pertaining to the individual's lifestyle the broadest reasonable interpretation and apply art according.

Moreover, if the instant invention is defined by additional features, such the verifying step, that the applicant argues distinguishes the invention from the prior art of record, then these features should also be recited in the claims.

(B) The applicant argues that "DeTore does not teach or suggest analyzing both present and future effects of those lifestyle choices as provided in provided in the claims of the present invention."

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Again, it is noted that the features upon which applicant relies (i.e. analyzing present and future effects of lifestyle choices) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The exemplary claims that the Applicant relies upon to point out this feature (claim 1, lines 3-4; claim 6; claim 7) do not expressly recite any limitations regarding analyzing present and future effects of lifestyle choices. As the Examiner understands the cited portions, claims 1 and 7 recite surveying for lifestyle and medical information, while claim 6 provides specific examples of the type of lifestyle information that is gathered. Furthermore, DeTore assesses the individual's use of alcohol, tobacco use and food intake as explained in the rejection of claims 5 and 6, and col. 12, lines 58-61.

(C) Applicant argues that DeTore's use of the survey and risk evaluation is solely for the purpose of determining whether coverage should be declined for the individual. Applicant further argues DeTore does not provide information on improving one's health.

In response to applicant's argument that the distinction of the applicant's invention over the prior art is that the survey and assessment are useful for improving an individual's health, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim

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drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, DeTore discloses a system and method that assesses an individual's medical and health risks to determine his or her insurable risk (col. 12, lines 37-col. 13, line 13), but also provides information on treatment (col. 21-22) (i.e. information on how to improve health).

(D) Applicant argues that a complete survey of an individual's health is not an obvious application of the DeTore reference because it is not the obvious practice of risk assessors to inquire into a wide variety of lifestyle factors.

In response, DeTore assesses a wide variety of factors relating to the health/ risk factors of an individual. (col. 12, line 58-col. 13, line 21) Moreover, the Examiner respectfully disagrees with the Applicant's assertion and submits that at the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to survey a wide variety of lifestyle/health factors for an individual. One would have been motivated to assess more factors to evaluate a potentially insurable risk in an improved, more consistent, and accurate manner (DeTore: col. 1, lines 55-58).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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